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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/600,083	09/13/2000	Timo Kauhanen	PM 271467	6680
909	7590	08/04/2005	EXAMINER	
PILLSBURY WINTHROP SHAW PITTMAN, LLP P.O. BOX 10500 MCLEAN, VA 22102			NGUYEN, HUY D	
			ART UNIT	PAPER NUMBER
			2681	

DATE MAILED: 08/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/600,083

Applicant(s)

KAUHANEN ET AL.

Examiner

Huy D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4, 21 is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 6, 8, 9, 11-15, 18-20, 23 and 25-28 is/are rejected.
- 7) ☒ Claim(s) 7, 10, 16, 17, 22 and 24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. In response to applicant's arguments, the recitation "two or more simultaneous separate calls to a subscriber unit" (as submitted in the Remarks) has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3, 5-6, 8-9, 11-12, 15, 18-20, 23, 26-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Grube et al. (U.S. Patent No. 5,371,898).

Regarding claims 1, 9, 11-12, 15, 18, 23, 26-27, Grube et al. teaches a method of controlling a multicall in a telecommunications system over a transmission path between a telecommunications network and a subscriber terminal, comprising setting up any new call in an existing multicall, when a criterion is met, by setting up said new call on an existing bearer such

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that said existing bearer is shared by at least two calls instead of by setting up said new call on a new bearer (Col. 2, lines 1-5).

Regarding claim 2, Grube et al. teaches the method according to claim 1, wherein a decision whether the new bearer is required or whether said existing bearer is to be used is made by the network according to said criterion (Col. 2, lines 1-5).

Regarding claims 3 and 20, Grube et al. teaches the method according to claim 1, wherein said criterion is a preference of a user of said subscriber terminal (Col. 2, lines 1-5).

Regarding claims 5-6, Grube et al. teaches the method according to claim 1, comprising indicating in a call setup signaling which existing bearer is to be used (Col. 2, lines 1-5).

Regarding claim 8, Grube et al. teaches the method according to claim 1, comprising changing a call currently being on a shared bearer to use a new dedicated bearer (Col. 2, lines 1-5).

Regarding claim 19, Grube et al. teaches the system according to claim 18, wherein a decision whether the new bearer is required or whether said existing bearer is to be used is made by the network according to said criterion (Col. 2, lines 1-5).

Regarding claim 28, Grube et al. teaches the subscriber terminal according to claim 27, wherein said terminal is a mobile station for a mobile communications system (Col. 2, lines 1-5).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grube et al. in view of Hoogerwerf et al. (U.S. Patent No. 5,819,171).

Regarding claims 13-14, Grube et al. teaches the method according to claim 12 except that the method further comprises step of alternating the calls on a shared bearer between an active mode and said hold mode by a user. However, the preceding limitation is taught in Hoogerwerf et al. (Col. 3, lines 19-39). It would have been obvious to one of ordinary skill in the art, at the time of the invention, to apply the teaching of Hoogerwerf et al. to the teaching of Grube et al. to provide flexibility for users.

6. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grube et al. in view of Dee et al. (U.S. Patent No. 6,115,602).

Regarding claim 25, Grube et al. teaches the system according to claim 18 except that the network is arranged to offer a new subscriber equipment terminating call to the g user by a call waiting supplementary service on a shared bearer either always or only when a maximum number of the bearers allowed has been used by the multicall. However, the preceding limitation is taught in Dee et al. (Col. 1, lines 14-22). It would have been obvious to one of ordinary skill in the art, at the time of the invention, to apply the teaching of Dee et al. to the teaching of Grube et al. to provide convenience for users.

***Allowable Subject Matter***

7. Claims 4 and 21 are allowed. The following is an examiner's statement of reasons for allowance:

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Regarding claims 4 and 21, the closest prior arts, Grube et al. and Hoogerwerf et al. (U.S. Patent No. 5,819,171); fail to teach step of indicating in a call setup signaling from said subscriber equipment to said network whether the new bearer is required or whether said existing bearer is to be used.

8. Claims 7, 10, 16-17, 22, 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Contact Information***


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huy D. Nguyen whose telephone number is 571-272-7845. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on 571-272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Huy Nguyen



JOSEPH FEILD  
SUPERVISORY PATENT EXAMINER